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EXAMINER

DICUS, TAMRA

ART UNIT PAPER NUMBER

1774

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,255

Applicant(s)

NISHIKAWA ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

This Office Action is responsive to the amendment filed 04-19-04.

Response to Amendment

The 112 rejection over claim 19 is withdrawn due to Applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,034,268 to Sekidou in view of USPN 6,159,605 to Hanada et al. and further in view of USPN 6,197,409 to Bodager et al. as previously set forth in the Office Action mailed 12/23/03.

To instant amended claim 6, that the printing layer has been printed by ink-jet printing is not a positive recitation to the claim. Further that a printing layer has been printed by ink jet printing is process derived and is not afforded patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product not a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and

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not of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Claims 1 and 9-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,034,268 to Sekidou in view of USPN 5,631,076 to Hakomori et al. and further in view of USPN 6,197,409 to Bodager et al. as previously set forth in the Office Action mailed 12/23/03.

Claims 14-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,034,268 to Sekidou in view of USPN 5,631,076 to Hakomori et al. and of USPN 6,197,409 to Bodager et al. and further in view of USPN 5,647,935 to Hoshino et al. as applied to claim 1 above as previously set forth in the Office Action mailed 12/23/03.

Claims 1 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,034,268 to Sekidou in view of USPN 6,159,605 to Hanada et al., USPN 6,197,409 to Bodager et al., and further in view of USPN 5,736,356 to Ueno et al. as previously set forth in the Office Action mailed 12/23/03.

Specification

The disclosure is objected to because of the following informalities: "two adhesive layer parts" is new matter as such limitations were not presented originally.

Appropriate correction is required.

The amendment filed 04-19-04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter

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into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “two adhesive layer parts” were not presented originally.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended claim 4 to recite “layer parts”. The Examiner believes that dependent claim 4 (amended) do not have the proper support in the original specification as filed because the specification does not provide any teaching or discussion on “layer parts” or its usage with Applicant’s claimed porous sheet.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. Claim 4 does not make sense because a layer (singular) cannot comprise two additional layer parts (plural). "Layer parts" is unclear and does not make sense how an adhesive layer comprises two adhesive layer parts. The Examiner does not know what this claim intends to encompass.

Response to Arguments

Applicant's arguments filed 04-19-04 have been fully considered but they are not persuasive.

Applicant alleges the new amendment is not new matter. However, this is not convincing as "adhesive layer parts" were not originally filed. Applicant points to page 14 of the specification, however, no where within that page or in the entire disclosure are any description or teaching of "layer parts". Thus the Applicant is required to cancel such new matter.

Applicant argues the application of Sekidou in view of Hanada and Bodager by alleging the three cited references are drawn to different utilities and thus believes they cannot be combined. The Applicant has not argued persuasively because all the aforementioned prior art references are used for printing. Because they are all from the same technical field, such as the printing media technology, motivation exists. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347,

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21 USPQ2d 1941 (Fed. Cir. 1992). Applicant argues Bodager and Sekidou have different printing techniques such as ink jet and offset lithography. However, Applicant does not claim any sort of ink jet or offset printing per instant claims 1-5 and 6-19. Moreover, that the end product is printed by a method is a process by product limitation and does not afford patentable weight. See MPEP 2113.

Applicant further argues Hanada is not drawn to a medium but rather to the actual printed sheet. Such assertion makes no sense because a printed media is equivalent to a printed sheet. Media is defined by what is recorded on the actual thing that receives something recorded, e.g. an ink (something recorded) on a sheet (media).

Applicant argues Sekidou has a completely different role from Bodager and one would not look to replace the other. However, the role or purpose of inventions need not be the same. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991) (discussed below). Although *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references “without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has

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done” (emphasis added), reading the quotation in context it is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention. Applicant further argues why Sekidou would need a porous layer. As previously set forth, the sheet of Sekidou would need a porous layer in order to improve the waterproofness or ink absorbency of the sheet as Hanada teaches (see col. 2, lines 61-68 and col. 7, lines 22+).

Applicant argues Sekidou not needing a release layer. Sekidou already provides an adhesive within the laminate sheet, a release layer would have been obvious to add, as taught within the technical field, because Bodager, an analogous art, teaches releasing layers (col. 3, lines 9-25) to impart releasing functionality. A *prima facie* case for obviousness has therefore been established. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed products. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). Applicant has not offered any objective evidence such as comparative test results to dispute the prior art of record.

Applicant further argues that while Sekidou discloses open and/or closed cells, a water passing property would not be provided. However, because there are cells, the sheet is porous

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and water will pass through any sheet that has cells. Applicant also alleges that because ink does not pass through the primer and support layer of Sekidou, that water could not pass because of the option of using closed cells. However, within that column further at line 14, closed and open cells are contrasted which would mean passage of ink is allowed, which would mean water could also pass. Moreover again, Applicant has not proven the combination would not work to provide such water passing property.

Applicant alleges the Examiner incorrectly assumes that all recording or printed sheets such as transfer medium, would be interchangeable. Applicant does not claim a transfer of any sort. Applicant merely claims a “porous sheet laminate”, which the prior art provides. In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., transfer medium) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the Examiner has not provided a reason for why hot melt ink would be employed to Sekidou. Again, a prima facie case of obviousness was established because the art all applies to the same technical field of printing media. One would therefore be motivated to provide hot melt ink because Hakomori provides the use of hot melt ink on recording sheets to impart enhanced color density as taught in the Abstract of Hakomori. The combinations are reasonable and valid as they all are to printed media and the modifications one could make to such recorded media.

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Applicant argues the use of Hoshino, alleging Hoshino adds nothing to the rejection because Hoshino does not require that their adhesive be porous. The Applicant has not persuasively argued. Hoshino was used as previously set forth, to teach a specific adhesive as per instant claim 14. Hoshino teaches an ink jet recording medium that provides an adhesive. The adhesives can include sticking agents as well as adhesives including a variety of types such as acrylic resin, ethylene-vinyl acetate (EVA) resin. See col. 3, lines 52-65. Hoshino teaches such material is a conventional material to use for ink jet recording media.

Applicant argues the use of Ueno, alleging Ueno adds nothing to the rejection because Ueno's cushion layer would not produce the instantly claimed invention. This argument is not persuasive because Ueno also is to a recorded media, receiving images on a sheet. The sheet is of a multilayer structure and thereby produces a laminate. Applicant claims a laminate. The art is combinable as Ueno is an analogous art.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tamra L. Dicus
Examiner
Art Unit 1774

July 8, 2004


RENA DYE
PRIMARY EXAMINER
A.U. 1774
Supervisory